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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,097	11/14/2003	Scott C. Harris	BARCODE-D1	9523
23844	7590	05/12/2004	EXAMINER	
SCOTT C HARRIS P O BOX 927649 SAN DIEGO, CA 92192			WALSH, DANIEL I	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 05/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,097

Applicant(s)

HARRIS, SCOTT C.

Examiner

Daniel I Walsh

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) 7-16, 32-37 and 44-47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 17-31 and 38-43 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11-03
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6, 17-31, and 38-43, drawn to a method for scanning a two-part barcode for decoding two sets of information through using two scanners, classified in class 235, subclass 462.10.
 - II. Claims 7-16 and 44-47, drawn to a barcode, classified in class 235, subclass 462.02.
 - III. Claims 32-37, drawn to a method for imaging a barcode, classified in class 235, subclass 462.24.
2. Inventions II and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the barcode can be read using a single scanner.
 3. Inventions I and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed of capable of use together. The systems that image a person and a barcode and decodes a two-section barcode using two separate barcode readers are unrelated.

4. Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the barcode can be read using a single scanner without an imager needed.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Scott Harris on 19 April 2004, a provisional election was made to prosecute the invention defined by claims 1-6, 17-31, and 38-43. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7-16, 32-37, and 44-47 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

10. Claims 1 and 3 are rejected under 35 U.S.C. 102(a) as being anticipated by Paul et al. (US 6,457,651).

Re claim 1, Paul et al. teaches scanning a bar code with a first scanner to obtain first information and scanning the bar code with a second scanner, different from the first scanner, to obtain second information different from the first information (abstract).

Re claim 3, Paul et al. teaches the first scanner and second scanner scan different parts of the code (abstract), as a first part is scanned (barcode) and a second part (glyph is scanned).

Further, the examiner notes it is well known and conventional to scan different parts of dual part barcodes to extract information.

11. Claims 17-18 and 24 are rejected under 35 U.S.C. 102(a) as being anticipated by Swartz et al. (US 6,655,597).

Re claim 17, Swartz et al. teaches forming a communication; forming a bar code as part of the communication, the bar code including scannable information, which when scanned, forms information that is supplemental to the communication through "A particular implementation of the present invention allows the consumer to subsequently download the information stored in the reader pen 90 in a manner described in more detail below. In particular the information can be downloaded to a personal computer or other access point to a computer or data network. The downloaded information can then be used in various different manners. For example the product can be ordered or additional information concerning the product can be accessed. A particular implementation proposed under the present invention is that the bar code symbol accompanying the advertisement contains sufficient information for the personal computer or access point to the computer network to access a site on the Internet (or comparable data storage system). This site can contain additional information concerning the advertised product, information concerning related products, price information, cross-references to further related sites, and the capability of ordering and paying for the product. This greatly simplifies the purchasing process and also ensures that the consumer does not forget a product which has caught his attention" (col 7, lines 41+). Re claim 18, it has been discussed above that the bar code provides additional information about the advertisement. Re claim 24, the barcode represents an address (website address) to additional information as discussed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 2 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al., as applied to claim 1 above.

The teachings of Paul et al. have been discussed above.

Paul teaches the use of conventional barcode readers, and mentions that one dimensional barcode readers are conventional (col 5, lines 1+), but does not refer to the barcode readers as 1-

D. Re claim 6, the examiner notes that it is well known and conventional in the art to decode information in a base N format, as is conventional in the art (type 39/128 for example). At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to use a 1-D barcode reader and base N decoding.

One would have been motivated to do this, since they are well known and conventional, and produce expected results in a reading process for conventional barcodes.

13. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al., as applied to claim 1 above, further in view of Lemelson et al. (US 6,032,861).

The teachings of Paul et al have been discussed above.

Paul et al. is silent to scanning in different directions.

Lemelson et al. teaches scanning in different directions (abstract).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Paul et al. with those of Lemelson et al.

One would have been motivated to do this to provide a means to efficiently read out data, store a dense amount of data, and also be downwardly compatible.

14. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul et al., as applied to claim 1 above, further in view of Kaufman et al. (US 6,070,805).

The teachings of Paul et al. have been discussed above.

Paul et al. is silent to second information being obtained from a color/grayscale.

Kaufman et al. teaches color being used to store information in a barcode (claims 1-8+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Paul et al. with those of Kaufman et al.

One would have been motivated to do this to have a barcode (colored) to provide robustness and reliability.

15. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 17 above, further in view of Spector (US 5,176,224).

The teachings of Swartz et al. have been discussed above.

Swartz et al. is silent to the barcode representing the time and place of some event, and entering the time and place into a computer doing the scanning.

Spector teaches such limitations (FIG. 3 and col 7, lines 61+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al. with those of Spector.

One would have been motivated to do this in order to add date sensitivity to scanned barcode information, as date sensitivity is well known and conventional with coupons, and therefore is analogous art to advertisements, which often times can be time sensitive as well.

16. Claims 21-23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 17 above, further in view of Knowles (US 6,622,917).

The teachings of Swartz et al. have been discussed above.

Swartz et al. is silent to the communication being an email.

Knowles teaches forming a communication in the form of an email, that includes several barcodes that are printed out upon printing of the email, which when scanned forms information that is supplemental to the email, by providing the data/information physically located on the sites (pictures, text, details, etc) (col 4, lines 33+). Re claims 22-23, Swartz et al. teaches that several barcodes can be associated with an email (col 4, lines 23+). Though Swartz et al. is silent to making a decision about the contents of the email being an acceptance or a rejection, the Examiner broadly interprets the subsequent scanning of the user, of the emailed barcodes as a form of acceptance (by scanning them), or a subsequent rejection by not scanning them.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al. with those of Knowles.

One would have been motivated to do this in order to provide a communication in a well-known and conventional format (email) that allows users to access specific/details information off the Internet.

17. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 17 above.

The teachings of Swartz et al. have been discussed above.

Though Swartz et al. is silent to accessing a publicly available database to obtain additional information, the Examiner notes that it has been taught above that a barcode of an advertised item can be scanned and used to direct a user to a website for further information.

Accordingly, it would have been well within the skill in the art to include a database linked to the code, such as a manufacturers website, that is accessed upon scanning of the barcode, to obtain further product information. Such modification would be obvious in order to provide additional data/information about a product, to a customer, where the data is stored in a conventional and easily accessible database format, which is commonly accessible via the Internet, for example.

18. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 17 above, further in view of Paul et al.

The teachings of Swartz et al. have been discussed above. The Examiner relies upon Swartz et al. to teach a barcode on a communication.

Swartz et al. is silent to the code containing an auxiliary code that is scanned to automatically take an action, though Swartz does teach automatically taking an action, as discussed above, by linking to the Internet.

Paul et al. teaches a barcode that includes primary and secondary coded information in the form of glyphs and linear barcode data (abstract). The examiner interprets this to include an auxiliary code, which is scanned to automatically take an action (i.e. extraction). The examiner also notes that it is well known and conventional in the art for scanning of a code to automatically take an action (Swartz et al. US 6,655,597). Re claim 28, Paul et al. teaches a dual type barcode with a first part that is interpreted by a first bar code scanning process to obtain first information and a second part which is interpreted by a second bar code scanning process to obtain second information that has more information than the first information (abstract). Re claim 29, it has been discussed above that the first part is a linear barcode and the second part is not, as it is a glyph which can include various types, (col 4, lines 56+). Further, the examiner notes that it is well known and obvious to use non-linear barcodes for secondary encoded information (see Williams US 5,920,062 and Oakeson et al. US 6,398,117, for examples).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al. with those of Paul et al.

One would have been motivated to do this to encode more information in a barcode.

19. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al./Paul et al., further in view of Lemelson et al.

The teachings of Swartz et al./Paul et al have been discussed above.

Swartz et al./Paul et al. are silent to scanning in different directions.

Lemelson et al. teaches scanning in different directions (abstract).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al./Paul et al. with those of Lemelson et al.

One would have been motivated to do this to provide a means to efficiently read out data, store a dense amount of data, and also be downwardly compatible.

20. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al./Paul et al., further in view of Kaufman et al.

The teachings of Swartz et al./Paul et al. have been discussed above.

Swartz et al./Paul et al. is silent to second information being obtained from a color/grayscale.

Kaufman et al. teaches color being used to store information in a barcode (claims 1-8+).

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Swartz et al./Paul et al. with those of Kaufman et al.

One would have been motivated to do this to have a barcode (colored) to provide robustness and reliability.

21. Claims 38-41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al.

The teachings of Swartz et al. have been discussed above, re claim 17, where a scanning of a barcode is used to access a website. Re claims 39-40, though Swartz is silent to a 2-D and 3-D barcode, the Examiner notes that such barcodes are well known and conventional for storing more data, and accordingly, their use is well within the skill in the art for encoding a greater amount of data, and therefore an obvious expedient (Knowles US 6,622,917 FIG. 8, for example). Re claim 41, it has been discussed above that it is well known and conventional for

barcodes to include different parts that include different data. Accordingly, encoded website information in one of those parts is well within the skill in the art, in order to encode website information, for linking purposes, for example.

22. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swartz et al., as applied to claim 38 above, further in view of Knowles.

The teachings of Swartz et al. have been discussed above.

Swartz et al. teaches a barcode associated with an advertisement, but is silent to receiving an email that includes an image of a barcode associate with an advertisement and decoding the image to form information.

Re claim 42, Knowles teaches receiving an email including barcodes, printing out the barcodes and decoding the barcodes to form information (col 4, lines 23+). This is broadly interpreted to including receiving representations/images of barcodes via email. Re claim 43, though Knowles is silent to the barcodes being associated with an advertisement, it is well known that advertisements can include decodable barcodes, as discussed above, for convenience. Therefore, such modification is an obvious expedient.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Knowles (US 6,345,764), Oakeson et al. (US 6,398,117), Nethery III (US 6,032,863), Williams (US 5,920,062), Braginsky (US 5,869,828), Swartz et al. (US 6,629,642), and Nakano et al. (JP 07244652).

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (571) 272-2409. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DW
4/20/04


KARL D. FRECH
PRIMARY EXAMINER